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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/820,377

Filing Date: March 27, 2001

Appellant(s): WILLIAMS ET AL.

APR 03 2007

GROUP 3600

Marilyn R. Khorsandi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/30/06 appealing from the Office action mailed 5/26/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application Number 09/684,861, No Opinion has been rendered.

Application Number 09/680,654, No Opinion has been rendered.

Application Number 09/685,077, No Opinion has been rendered.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. 112 1st paragraph rejection for claims 10, 11, 13 and 14.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2001/0034608	GENDREAU	10-2001
US 2003/0115144	STEFIK et al.	6-2003
6,233,568	KARA	5-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Amendment

1. The amendment filed 1/18/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims have added the following limitations which are not supported by the original specification “the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels” the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being “restricted from finalizing the shipping labels” does not appear in the specification, therefore the appellant not having support for this phrase in the original disclosure. Appellant is invited to point to a specific page in the specification where it discloses that printing a shipping label is considered to be finalizing a label.

Appellant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

See above “objection to amendment” for reasoning.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 10-14, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau (US 2001/0034608) in view of Stefik et al (US 2003/0115144).
3. With respect to Claim 7: Gendreau discloses the use of a management computer system used for carriers, where the system:

- a. Receives a request to ship a parcel where the request contains partial shipment information comprising names and addresses (Paragraph 0032);

- b. Generating and printing a traveler label comprising a barcode (Invoice 22, Paragraph 0032).
- c. Save in memory, a relationship between the machine-readable code and the set of partial shipment information (Paragraphs 0032, 0033 and 0042), Gendreau discloses saving the information with bar-coded information, therefore due to the fact that the barcoded information is saved along with the data, the examiner considers that to be a relationship between the code and the information. Furthermore Gendreau discloses the information can be analyzed and consolidated for shipping, therefore the information is saved for that, and the shipping labels can be printed at an end of the day processing, therefore the information is retrieved from memory to print the shipping label.
- d. Generate a shipping label comprising the partial shipment information (27).

4. Gendreau however, fails to disclose the computer system being capable of assigning printing rights to a user, whether the user is designated as being able to print a shipping label, and finalize a shipping label. Stefik, discloses a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gendreau, to allow for the restricting of printing and finalizing documents, in order to control the use of a digital work (See Stefik, abstract).

4. With respect to Claim 23: See Gendreau Paragraphs 0032 and 0040 and 0042.

5. With respect to Claims 24 and 25: See Gendreau Figure 1 with corresponding detailed descriptions.

6. With respect to Claim 26: See Gendreau Paragraphs 0034 and 0050.

5. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau (US 2001/0034608) in view of Stefik et al (US 2003/0115144), and further in view of Kara (6,233,568).

7. With respect to Claim 10: Gendreau discloses the use of a management computer system used for printing invoices and shipping labels but fails to disclose designating users as having printing privileges and shipping privileges. Stefik discloses a computer system which is programmed to:

a. According to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). The examiner considers the system of Stefik to be fully capable of being used with shipping labels and shipping requests due to the fact that this is considered to be intended use. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the computer system of Gendreau, to include the privileges for restriction of privileges, as taught by Stefik, in order to control the use of digital works and images. (See Stefik, abstract)

b. Gendreau and Stefik fail to disclose the use of an interactive graphic user interface, in response to an input by a first user. Kara discloses the use of a system and

method for selecting a carrier, based on shipping rates, where a user logs into an account (therefore has shipping privileges), and an interactive user interface is displayed for the selection of a carrier (See Figures 4B and 8A, with corresponding detailed description).

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Gendreau and Stefik, to include an interactive user interface, in order to provide a user with information to make an informed choice as to a most preferable method of shipment. (See Kara, abstract, and Column 6)

8. With respect to Claims 11 and 13: See Gendreau Paragraphs 0032,0033, 0042 and 0050.
9. With respect to Claim 12: See Gendreau Paragraph 0034.
10. With respect to Claim 14: See Gendreau Paragraphs 0032-0034.

(10) Response to Argument

With respect to Issue 1 (a and b): Regarding the rejection of Claims 7, 10, 11, 13 and 14 under 35 USC 112 1st paragraph, First It should be noted that the rejection under 112 1st paragraphs for claims 10, 11, 13 and 14 has been withdrawn in light of the arguments. With respect to the term “restricted from finalizing shipping labels” limitation: In the claims the appellant has claimed “the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels”. The appellant recites a portion of the specification to provide support which states that a user can be “restricted from printing” and states that the specification recites that printing a shipping label “is one form of” finalizing shipping labels, therefore the specification provides support for restricted from finalizing. As pointed out by the appellant, printing a shipping label is only “one form of” finalizing the

shipping label, therefore where as the specification provides support for a user being restricted from printing a shipping label, there is no support in the specification for any other form of finalizing to be restricted. Therefore appellant does not provide support for the entire scope of the word “finalizing” being restricted, therefore the phrase “the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels” is considered to be new matter.

With respect to Issue 2a-1 in regards to the combination of Stefik with Gendreau: the appellant has argued that there is no teaching or suggestion to combine Stefik with Gendreau with respect to the limitations of Claims 7, 23, 24 and 25: As stated in the grounds of rejection above, the examiner has stated that Gendreau fails to disclose the computer system being capable of assigning printing rights to a user, whether the user is designated as being able to print a shipping label, and finalize a shipping label, therefore Stefik is used to cure this deficiency. Stefik discloses the rights of printing are in accordance with a digital work, therefore the appellant has argued that the “control the use of a digital work” reason used for the combination of references is misplaced due to the fact Stefik attaches a usage right for a digital work to the digital work, as opposed to the current invention assigns rights to a user to perform a particular action. First it should be pointed out that the shipping label is in a digital form before it is printed, therefore considered to be a digital work. Also, Stefik, discloses in Paragraphs 0016, 0040 and 0065-0067, the use of a repository which stores the digital rights. Therefore the examiner considers combination of Gendreau to be proper and there to be proper motivation to combine the analogous references due to the fact that they both deal with rights of a digital work.

In many, if not most, situations, there is neither a motivation or make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether "a person of ordinary skill in the art would have had sufficient motivation to combine the individual elements forming the claimed invention. Stefik discloses a motivation to assigning rights is to control a digital work, the examiner considers the shipping label before printing to be a digital work, therefore if one was looking to control the printing and finalizing of a shipping label, one of ordinary skill in the art would have sufficient motivation to use Stefik due to the fact that Stefik controls digital work, in which the shipping label is.

Although our predecessor court was the first to articulate the motivation-suggestion teaching test, a related test, the analogous art test, has long been part of the primary Graham analysis articulated by the Supreme Court. The analogous-art test requires that the Board show that a reference is either in the field of the appellant's endeavor or is reasonable pertinent to the problem with which the inventor was concerned in order to rely on the reference as a basis for rejection. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is necessary to consider the reality of the circumstances, in other words, common sense, in decided in which fields a person of ordinary skill would reasonable be expected to look for a solution to the problem facing the inventor. In the present case, the problem facing the inventor was assigning rights to a shipping label in its

digital form before printing, therefore one of ordinary skill in the art would have looked at the rights of digital works art to find a solution.

With respect to Issue 2a-2: there is no teaching or suggestion to combine Stefik with Gendreau with respect to the limitations of Claims 10-14. It should be noted that the appellant has stated that there is no teaching or suggestion to combine Stefik and Gendreau, however in the appellants arguments, the appellant is really arguing that Stefik does not disclose the claimed limitation, not that there is fault with the motivation. The appellant is arguing that Stefik discloses the rights to be attached to a user, as compared to the claimed limitations of indicating for each user of a plurality of users, a restriction from taking a particular action. In Paragraph 40, Stefik discloses that “usage rights” are rights granted to a recipient of a digital work and in Paragraph 0046 discloses the use of authorizations being stored for a user to gain access to the digital work. Claim 10, states instructions being input by the administrator, and designated in memory, a set of shipping privilege settings identifying at least a second user (indicating the instructions can be for multiple users) within the enterprise as authorized to print shipping labels according to a pre-processing shipping request, indicating one request. Therefore the instructions/privilege can be for multiple users to one request, which equates to multiple user for one digital work, which is what the appellant is arguing Stefik discloses. Furthermore, the claims are directed to storing the instructions in memory, but never disclose where the memory is located and how the instructions are stored, therefore still broad enough to read that the instructions are stored with the shipping label/digital work, which Stefik discloses in the repository. Furthermore, Stefik discloses the “usage rights” can be different privileges, such as printing, transferring or copying, therefore claiming multiple instructions in terms of rights.

Therefore the examiner considers Stefik to disclose the limitations as claimed and therefore one of ordinary skill in the art would be motivated to combine Stefik with Gendreau.

With respect to Issue 2b: Gendreau nor Stefik does not anticipate, disclose, teach or suggest all the claim limitations of Claims 7, 23, 24 and 25. The appellant has stated that neither Stefik nor Gendreau, whether considered alone or in combination with any other reference disclose “generate a printable barcoded pre-processing traveler label... comprising.... A machine-readable code....” and will save in memory “...a relationship between the machine-readable code and the set of partial shipment information”. The appellant is arguing that the information in Gendreau pre-exists and is not generated. As indicated in the rejection, the examiner considers the invoice to be a pre-processing traveler label. Gendreau discloses the inputting computer readable invoice information using a barcode-scanner, therefore the invoice must have a barcode in order for the system to scan it. As stated above in the grounds of rejection, Gendreau discloses the information is saved in order to be analyzed and consolidated, and discloses that the bar-coded information is saved along with the data, therefore the examiner considers that to be a relationship between the code and the information. This has been stated in the rejection, and it should be noted that the appellant has not pointed out how this reasoning is flawed.

Appellant further argues that Stefik fails to disclose first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels. The appellant is arguing that Stefik discloses the rights to be attached to a user, as compared to the claimed limitations of indicating for each user of a plurality of users, a restriction from taking a particular action. In Paragraph 40, Stefik discloses that “usage rights” are rights granted to a recipient of a

digital work and in Paragraph 0046 discloses the use of authorizations being stored for a user to gain access to the digital work. Claim 7, discloses setting user rights to finalize or be restricted from finalizing a shipping label. Therefore the instructions/privilege can be for multiple users to one request, which equates to multiple user for one digital work, which is what the appellant is arguing Stefik discloses. Furthermore, the claims are directed to storing the instructions in memory, but never disclose where the memory is located and how the instructions are stored, therefore still broad enough to read that the instructions are stored with the shipping label/digital work, which Stefik discloses in the repository. Furthermore, Stefik discloses the “usage rights” can be different privileges, such as printing, transferring or copying, therefore claiming multiple instructions in terms of rights. Therefore the examiner considers Stefik to disclose the limitations as claimed and therefore one of ordinary skill in the art would be motivated to combine Stefik with Gendreau.

With respect to Issue 2c: argument regarding Stefik nor Gendreau displaying interactive graphic user interface shipping selection options: It should be noted the rejection, as stated above, does not state that Stefik nor Gendreau discloses the display. A third reference is used to show this claim limitation.

With respect to Issue 3: Appellant argument that there is no disclosure in Kara, Gendreau or Stefik of displaying interactive user graphics. As stated above, and in the grounds of rejection, The deficiency in Gendreau and Stefik, lies in the fact that they fail to disclose the use of an interactive display, Kara is used to teach this limitation. The appellant is arguing that Kara does not disclose the information being displayed to the user “according to the shipping priveledges”. As stated by the examiner in the body of the rejection, in Kara, the display is displayed to a user based on the user logging onto an account. Once logged in the user has access to information, therefore the information is provided based on the priveledges (if the user had no account and could not log in the user would not have any privileges of using the system). The appellant has stated that Kara does not disclose the claimed limitation, however has not argued the examiner’s interpretation of the reference. The examiner considers Kara to disclose this limitation, therefore the rejections stand as stated above.

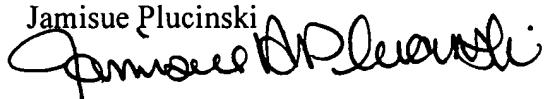
(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner’s answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jamisue Plucinski



Conferees:

Janice Mooneyham

Vincent Millin

